

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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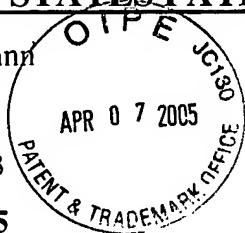
Applicant: David Vaughn

Serial No.: 10/622,847

Filed: July 18, 2003

Date Due: April 9, 2005

Title: OPTICAL THROUGHPUT CONDENSER



Examiner: John A. Ward

Group Art Unit: 2875

Docket No.: A126.115.102

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

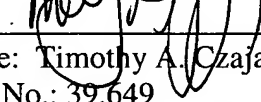
Sir/Madam:

We are transmitting herewith the attached:

- ☒ Transmittal Sheet containing Certificate of Mailing (1 pg.).
- ☒ Response to Restriction Requirement (3 pgs.).
- ☒ Return Postcard.

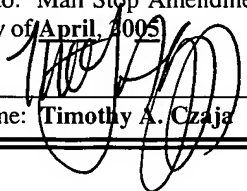
Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers, if appropriate. At any time during the pendency of this application, please charge any additional fees or credit overpayment to Deposit Account No. 500471.

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By: 
Name: Timothy A. Czaja
Reg. No.: 39,649

CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 3rd day of April, 2005

By: 
Name: Timothy A. Czaja

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RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed March 9, 2005, in which a Restriction Requirement was set forth under 35 U.S.C. §121 for Invention I (claims 1-8) and Invention II (claims 9-16). Applicant provisionally elects Invention II (believed to be claims 9-15), and traverses the requirement for the following reasons:

As a starting point, it is respectfully noted that Invention II is identified in the Office Action as encompassing "claims 9-16". The application as filed includes claims 1-15 (i.e., a claim 16 has not yet been filed). Thus, it is assumed that the Examiner intended Invention II to encompass claims 9-15.

The Office Action appears to set forth three different theories for requiring claim restriction. The first theory references MPEP §806.05(c), asserting that "Inventions I and II are related as combination and subcombination." Though not specifically stated, as set forth in MPEP §806.05(c), in order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. Thus, in turn, requires the Examiner to show both that: (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other and different relations. Relative to the first factor, it is respectfully submitted that the Examiner has not met this burden. In particular, the Examiner states that "the combination as claimed does not require the particulars of the subcombination as claimed because the method of making the condenser. The subcombination has separate utility such as illuminating light guides or providing illuminated optical." The second sentence appears to address the second, two-way

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distinctiveness factor. However, Applicant respectfully queries as to the intended meaning of the first sentence, as it does not point to any “particulars” of the subcombination not required by the combination. Further, the Examiner’s apparent assertion that “the method of making the condenser” is a “claimed” combination or subcombination is not understood. Pointedly, claim 9 (identified by the Examiner as being encompassed by Invention II) recites the same limitations as claim 1 (identified by the Examiner as being part of Invention I), along with an illuminating source. Thus, if Invention I is viewed as being the subcombination and Invention II as being the combination, the first, two-way factor has not, and cannot, be met. Thus, it is respectfully submitted that restriction pursuant to MPEP §806.05(c) is not proper.

A second basis for restriction provided in the Office Action is with reference to MPEP §806.05(e), asserting that Inventions I and II are related as process and apparatus for its practice. It is respectfully submitted that the Examiner’s reasoning for imposing restriction under this theory does not apply. In particular, the Examiner asserts that “in this case, the structural limitations of the condenser cite the all the limitations in the first set of claims and the second set of claims cite the apparatus of the condenser with a light source.” It is unclear as to how this statement shows that either: (1) “the process as claimed can be practiced by another materially different apparatus or by hand”, or (2) “the apparatus as claimed can be used to practice another and materially different process” (as otherwise required by MPEP §806.05(e)). It is respectfully submitted that the Examiner’s reasoning does not address either factor. To the contrary, the reasoning provided does not make any process/apparatus analysis. Further, it is respectfully noted that claim 1 (identified by the Examiner as being part of Invention I) and claim 9 (identified by the Examiner as being part of Invention II) are both apparatus claims, such that restriction between Inventions I and II under MPEP §806.05(e) does not appear to apply. Thus, it is respectfully submitted that the Examiner has not met the burden required by MPEP §806.05(e), such that restriction under this theory is improper.

Finally, the Office Action asserts that restriction is proper pursuant to MPEP §806.05(i). It is noted, however, that MPEP §806.05(i) relates to an application containing claims to a product, claims to a process especially adapted for making the product, and claims to a process of using the product. None of the pending claims claimed a process for making a product.

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Further, claim 1 (identified by the Examiner as being part of Invention I) and claim 9 (identified by the Examiner as being part of Invention II) are apparatus claims such that MPEP §806.05(i) cannot render Inventions I and II distinct. Further, the Examiner has incorporated form paragraph 8.20.01 in alleging the applicability of MPEP §806.05(i). As noted in this section of the MPEP, this form paragraph is to be used when claims are presented to the product, process of making, and process of using where the product claim(s) are not allowable. It is respectfully submitted that the Examiner has not identified these three distinct classes of claims, nor has the Examiner identified how the product claims are not allowable. Therefore, it is respectfully submitted that restriction under MPEP §806.05(i) is improper.

In light of the above, it is respectfully submitted that the Restriction Requirement has been traversed.

Having thus addressed the Restriction Requirement imposed by the Examiner, examination of the pending claims is respectfully requested.

Respectfully submitted,

David Vaughnn,

By his attorneys,

DICKE, BILLIG & CZAJA, PLLC

Fifth Street Towers, Suite 2250

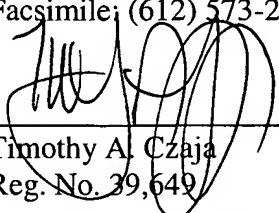
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The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 5th day of April, 2005.

By 
Name: Timothy A. Czaja